UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,882	11/09/1999	DON A. VAN DYKE	0100.9900960	7260

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VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LASALLE STREET
CHICAGO, IL 60601

EXAMINER
TREAT, WILLIAM M

ART UNIT	PAPER NUMBER
2183	8

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	**Application No.** 09/436,882	**Applicant(s)** VAN DYKE, DON A.
	Examiner William M. Treat	**Art Unit** 2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 September 2003</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-13,15, and 17-18* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-13,15, and 17-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6)☐ Other: .

1.   Claims 1-6, 8-13, 15, and 17-18 are presented for examination.

2.   Applicant has asked the examiner to withdraw the finality of his previous rejection based

on his application of Favor (WO 97/13194) to claims 1-6, 10-13, and 15. If applicant will review

his original claim dependency diagram, he will see that claims 2-6, 11-13, and 15 represent

combinations of claim elements never previously claimed. Therefore, application of Favor was

entirely appropriate. Whether the examiner should have listed amended claims 1 and 10 in the

form paragraph stating the grounds for rejecting applicant's claims over Favor is a matter of

form over substance. If the examiner had omitted claims 1 and 10 from the form paragraph, he

would still have rejected their substance since claims 2-6, 11-13, and 15 contain all the elements

of the claims from which they depend. However, rather than belabor the point, the examiner will

merely provide applicant with a new rejection.

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-6, 8-13, 15, and 17-18 are rejected under 35 U.S.C. 102(b) as being clearly

anticipated by Favor (WO 97/13194).

5.   The rejection and arguments presented in the examiner's previous actions (Paper No. 5,

mailed 12/16/02) continue and are hereby incorporated by reference. Applicants will notice that

the examiner has simplified matters for them by using only Favor to reject all of their claims.

This will result in the examiner writing an additional action for them, but it will simplify matters

in the long run.

6.   Applicant's arguments filed 9/30/03 have been fully considered but they are not

persuasive.

7.   Applicants have argued in relation to Favor (a) the examiner failed to establish a prima

facie case of anticipation by failing to show how each and every element in the claims is taught

by the reference; (b) Favor fails to teach "determining whether the at least one flag modification

enable bit allows updating of at one least flag in response to executing the operational code; (c)

Favor teaches decoupling of condition codes from operation rather than "determining whether

the at least one flag modification enable bit allows updating of at least one flag in response to

executing the operational code"; and (d) claim 5 requires providing a variable length instruction

emulator that uses fixed length native instructions as the at least one instruction, to emulate

variable length instructions and evaluating the flag modification bit to preserve flag bit settings

for variable length instructions that are emulated using the fixed length native instructions.

8.   As to 7(a), if applicant's representative will review the MPEP, he will see provision in it

for form paragraphs such as 15.12 where the language "clearly anticipated" is used. The concept

behind a clearly-anticipated reference is that "one of ordinary skill in the art" should be able to

read the reference and see that his/her claims are anticipated by the reference. In this case the

applicant, clearly one of ordinary skill in the art, is assisted by trained counsel who can help with

any necessary examination of the scope of applicant's language. Should applicant fail to

understand some aspect of the reference in relation to the scope of his claim language, he has the

opportunity to raise such issues as applicant has done as noted by the examiner in 7(b), 7(c), and

7(d). The examiner also provides his phone number and is willing to answer questions related to

his interpretation of the reference and applicant's claim language. The examiner did suggest

certain minimal reading (page 35, line 1 through page 38, line 11). However, if applicant or his

representative failed to understand the reference's relevance to their claims after reading that

minimal amount, there is nothing in the MPEP that excuses applicant or his representative from

making a good faith effort to read and understand the reference before responding to the

examiner's rejection.

9.   As to 7b), if applicant will reread the minimal material suggested by the examiner, he

will see that Fig. 6A shows the RISC-type instruction format of Favor's invention for his

instruction types listed from page 35, line 12 through page 36, line 16 and that each of these

instructions contains "a single-bit set status field (SS) field 624 at bit location [9]" (page 35, lines

7-8). Also, on page 36 at lines 25-28, part of the suggested minimal reading, it states, "**For Ops**

in which the set status (SS) field 624 is set to 1, indicating that this op does modify flags, the

extension field (EXT) 614 specifies four status modification bits designating the groups of flags

that are modified by the Op." Finally, on page 38 at lines 7-9, part of the suggested minimal

reading, it states, "Decoupling of condition code handling from operation type, using the

independent TYPE 612 and set status (SS) field 624, allows some operations to be defined which

do not update the flags." Inherently, Favor's system must determine whether bit 624 is set when

processing 612-type instructions and then will update at least one flag when the bit is set. As

with applicant's system, when the bit is not set, the flag or flags will not be updated.

10.   As to 7 (c), see paragraph 9, *supra*.

11.   As to 7 (d), the examiner thought applicant would readily recognize the assignee of

Favor's invention as a company which provides a "variable length instruction emulator that uses

fixed length native instructions as the at least one instruction, to emulate variable length

instructions". However, if this fact has somehow escaped applicant's recognition, the examiner

would suggest applicants read Favor's description of the Technical Field of his invention which

is converting x86 instructions into RISC-type instructions for execution on a RISC-type core

(page 1, lines 1-2). This is the same thing applicant is doing and claiming in the first part of

claim 5. As to the language "evaluating the flag modification bit to preserve flag bit settings for

variable length instructions that are emulated using the fixed length native instructions", the

examiner made it clear in paragraph 9, *supra*, that Favor's flag modification bit (624) in his fixed

length native instructions is evaluated to determine if flag bit settings will be preserved or

modified.

12.   The question becomes does Favor make provision for preserving flag bit settings for

variable length instructions (i.e. the x86 flags). On page 36 at lines 23-25, part of the suggested

minimal reading, Favor states, "The set status (SS) field 624, in combination with the EXT field

614, is used to designate the status flags that are affected by an operation." On page 38 at lines

1-2, part of the suggested minimal reading, Favor states, "The EXT field 614 is used to update

condition flags including six flags corresponding to x86 flags." Clearly, Favor makes provision

for preserving the x86 flags (i.e. the flag bit settings for the variable length instructions) as

applicant is claiming.

13.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

14.   Kiuchi et al. (Patent No. 5,832,258).

15.   Sharangpani (Patent No. 5,590,359).

Any inquiry concerning this communication should be directed to William M. Treat at telephone number 703 305 9699. The examiner works at home on Fridays but may normally be reached on Fridays by leaving a voice message using his office phone number. The examiner also works a flexible schedule but may normally be reached in the afternoon and evening on three of the four remaining weekdays.

WILLIAM M. TREAT
PRIMARY EXAMINER